



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

sshoppe  
1-10-02  
21/Terminal  
Disclaimer

Applicant(s): Eliyahou Harari, et al.  
Assignee: SanDisk Corporation  
Title: FLASH EEPROM SYSTEM WITH PROGRAMMING VERIFICATION  
Serial No.: 09/129,675 Filing Date: August 5, 1998  
Examiner: Andrew Q. Tran Group Art Unit: 2824  
Docket No.: M-10187-28C US

San Francisco, California  
October 30, 2001

COMMISSIONER FOR PATENTS  
Washington, D. C. 20231

TERMINAL DISCLAIMER TO OBVIATE A  
DOUBLE PATENTING REJECTION OVER A PATENT

Sir:  
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01/04/2002 BROWN  
01 FC:140

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The undersigned certifies, on behalf of SanDisk Corporation, that, to the best of his knowledge and belief, SanDisk Corporation ("Owner") is the owner of the entire interest in the above-captioned divisional patent application and of prior parent Patent No. 5,172,338 ("Prior Patent"), by way of the following identified assignment and change of name, copies of which are attached hereto and which have been reviewed by the undersigned:

1) For the Prior Patent, by way of a written Assignment from the inventors to SunDisk Corporation, dated 06/08/90, of patent application serial no. 07/508,273, filed April 11, 1990, recorded in the United States Patent and Trademark Office at reel/frame 5353/0505; and

2) By way of a written Change of Name of SunDisk Corporation into SanDisk Corporation dated 08/25/95, recorded in the United States Patent and Trademark Office at reel/frame 7709/0577.

The Owner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-captioned patent application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156

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3300

and 173, as presently shortened by any terminal disclaimer, of the Prior Patent. The Owner hereby agrees that any patent so granted on the above-captioned application shall be enforceable only for and during such period that it and the Prior Patent are commonly owned. This agreement runs with any patent granted on the above-captioned patent application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the Owner does not disclaim the terminal part of any patent granted on the above-captioned patent application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the Prior Patent, as presently shortened by any terminal disclaimer, in the event that the Prior Patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

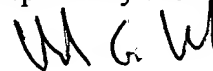
In compliance with 37 C.F.R. § 1.20(d), the commissioner is authorized to charge the fee of \$110.00 to Deposit Account No. 19-2386 for this Terminal Disclaimer as set forth in the enclosed transmittal letter.

This Terminal Disclaimer is being made by the undersigned.

EXPRESS MAIL LABEL NO:

EL 873331495 US

Respectfully submitted



Michael G. Cleveland  
Attorney for Applicant(s)  
Reg. No. 46,030

**TERMINAL DISCLAIMER  
APPROVED**

JAN 10 2002

**TECHNOLOGY CENTER 2800  
SPECIAL PROGRAM CENTER**



Sharon Hoppe

**Supervisory Legal Instrumental Examiner  
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Paralegal Specialist

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DATE: 10-Jan-02

APPL. S.N.:

09/129,675  
09/991,105TO: EXAMINER Tran, Andrew

ART UNIT:

2824FROM: Hoppe, Sharon

PARALEGAL SPECIALIST

RETURN THIS MEMO TO: CP4-6D28SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 30-Oct-01

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶ 14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶ 14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney “of record” (see ¶ 14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
    - ☐ is not recognized as an officer of the assignee (see ¶ 14.29 & possible 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
  - ☐ The T.D. is not signed (see ¶ 14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶ 14.26, 14.27.02 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶ 14.26, 14.27.02 or 14.26.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

Log Date: \_\_\_\_\_